

REMARKS

Claims 1-8, 21-25, and 38 remain in this application with claims 1, 21, and 38 in independent form. Claims 9-20, 26-37, and 39-40 have been cancelled.

The subject application claims priority to United States Application No. 09/966,234 filed on September 28, 2001 (hereafter the "parent application"). A copy of the recorded declaration is included as Exhibit A. Applicant has uncovered that the patent application transmittal sheet erroneously indicated a different application (09/724,093), while the declaration and specification correctly referred to the parent application. A supplemental application data sheet is being concurrently submitted herewith to correct the typographical error.

Further, the Examiner states that the parent application was abandoned prior to the filing date of the subject application and therefore the priority is not considered. Applicant submits herewith, as Exhibit B, a copy of a Petition for a Two-Month Extension of Time that was filed in the parent application, and as such, the parent application was pending at the filing date of the subject application.

More specifically, the parent application received a Notice of Missing Parts on November 5, 2001 granting a filing date of September 28, 2001. The Notice of Missing Parts gave a shortened statutory period of reply of two months, expiring on January 5, 2002. Applicant filed a Petition for a Two-Month Extension of Time on February 19, 2002. Therefore, the parent application was pending until March 5, 2002. The subject application was filed on March 1, 2002, which resulted in pendency between the parent application and the subject application. Accordingly, it is requested that priority be recognized by the Examiner, as the requirements for establishing such priority have been previously satisfied.

Claim 1 stands objected to for including the phrase "for play by a player". The Examiner states that the phrase should be corrected to "for playing by a player". As suggested, Applicant has amended claim 1 accordingly.

Claims 1-5, 21-25, and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Crawford (United States Patent Application No. 2003/017868A1) in view of Kaplan (United States Patent No. 5,413,342). The Examiner states that Crawford teaches a video slot gaming machine comprising predetermined vertical paylines.

Applicant submits herewith a 37 C.F.R. §1.131 Declaration swearing back of Crawford. The declaration is submitted by Steve Sutherland, the Executive Vice President & C.O.O. of the Assignee, Konami Gaming, Inc. A copy of the filed Assignment is attached at Exhibit C and was previously recorded on April 30, 2002 at reel 012862, frame 0219. As set forth in the Manual of Patent Examining Procedure (MPEP) §715.04, the Assignee may make a declaration under 37 C.F.R. §1.131 when it is not possible to produce the declaration from the inventors. *Ex Parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903). In the subject application, each of the inventors, R. Savio, M. Karen, B. Schultz, S. Falstrom, and R. Foresta, are no longer with Konami Gaming, Inc. Further, the inventors have not been with Konami Gaming, Inc. since shortly after the filing of the subject invention, about two years. As such, it has not been possible to produce a declaration from the inventors.

Crawford has an effective filing date of July 19, 2001. One possible method of swearing back of the reference, is to show reduction to practice prior to effective filing date of July 19, 2001. Sufficient facts are present and alleged in the Declaration of Mr. Sutherland to establish that the subject invention was reduced to practice prior to July 19, 2001. Specifically, upon reviewing the development history for the game, Mr. Sutherland uncovered facts that a game having vertical paylines was reduced to practice prior to the effective filing date of Crawford. These facts included a single compact disc prepared by the inventors during the development of the game. The compact disc was dated prior to July 19, 2001 and was signed by each of the inventors. Further, additional hand sketches were uncovered illustrating a game with vertical paylines as claimed herein. The hand sketches were dated prior to July 19, 2001. Based upon these facts, the subject invention was reduced to practice prior to July 19, 2001 and 35 U.S.C. §103(a) rejection should be withdrawn.

Accordingly, it is respectfully submitted that the Application, as amended, is now presented in condition for allowance, which allowance is respectfully solicited. Applicant believes that no fees are due, however, if any become required, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account 08-2789. Further and favorable reconsideration of the outstanding Office Action is hereby requested.


Applicant: Savio et al.
Serial No.: 10/082,540
Group Art Unit: 3713

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS, P.C.

April 7, 2004

Date



James R. Yee, Reg. No. 34,460

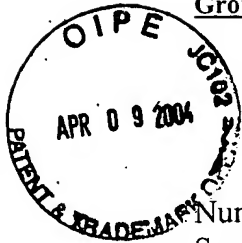
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Serial No.: 10/082,540
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CERTIFICATE OF MAILING

I hereby certify that this Amendment for United States Patent Application Serial Number 10/082,540 filed March 1, 2002 is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on April 7, 2004.

Melissa Dadisman
Melissa Dadisman

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